UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,795	04/21/2004	Eckard Weber	OREX.001A	5046

20995 7590 09/24/2007

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
KWON, BRIAN YONG S	

ART UNIT	PAPER NUMBER
1614	

NOTIFICATION DATE	DELIVERY MODE
09/24/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No.	Applicant(s)	
	10/828,795	WEBER ET AL.	
	Examiner	Art Unit	
	Brian S. Kwon	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *50-66* is/are pending in the application.

4a) Of the above claim(s) *54 and 59* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *50-53,55-58 and 60-66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

1. Acknowledgement is made of applicant's filing of an amendment/remarks on 06/29/2007. By the amendment, claims 1-49 have been cancelled and claims 50-66 have been newly added.

2. Claims 50-66 are currently pending in the application. However, claims 54 and 59 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention. It is noted that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of actions being applied to the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 50-53, 55-58 and 60-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Malley et al. (US 6004970) in view of applicant's admission of the prior art of record (para. [0100]), and further in view of Li (US 6589553) and Cook (US 6071918).

O'Malley discloses the administration of opioid antagonist (i.e., naltrexone) in combination or conjunction with antidepressant such as bupropion hydrochloride or Wellbutrin, with/without nicotine, for the treatment of smoking cessation (column 6, lines 1-6), wherein said composition is prepared and administered either concurrently or simultaneously in various dosage forms known in the art (any conventional means) including sustained release preparation, oral, intravenous, intramuscular or intradermal, e.g., by sterile injections, including depot

versions, implants, parenteral administration; wherein naltrexone is administered in 2 to 10mg (bolus), 0.2 to 1.0 mg/hr (a continuous drip) or 25 to 100mg (orally as Revia tablet); and wherein said composition is delivered in a sustained release preparation (column 4, lines 18-26; column 5, lines 27-33; column 6, lines 6-24).

Applicant admits that various sustained-release materials have been established and are well known by those skilled in the art.

Li and Cook are being supplied as references to demonstrate the routine knowledge in preparing naltrexone and bupropion in controlled or sustained release formulation. Li also teaches an advantage of delivering bupropion in sustained release formulation for greater convenience and improving compliance (column 2, lines 41-45).

The teaching of O'Malley differs from the claimed invention mainly in the incorporation of sustained-release bupropion into said combination. To incorporate such teaching into the teaching of O'Malley, would have been obvious in view of Applicant's admission and/or USP'716 and USP'918 that the preparing bupropion in controlled or sustained release formulation is well known in the art.

One having ordinary skill in the art would have been motivated to make such modification, with the reasonable expectation of success, to extend the usage of the claimed composition by preparing said composition in sustained release formulation to accommodate patients' preference and needs where the compliance could be improved with effective and/or well tolerated dosage regimen.

As discussed above, there are general references indicating that pharmaceuticals generally may be delivered sustained release, as well as disclosing benefits or advantages to be

achieved by sustained release forms versus other modes of administration. Therefore, there exist general art accepted motivations for formulating drugs for sustained release formulation.

With respect to the claimed oral dosage forms, those of ordinary skill in the art would have been readily optimized effective dosages forms as determined by good medical practice and the clinical condition of the individual patient to maximize the efficacy of the drugs. Furthermore, determination of the appropriate dosage forms for treatment involving each of the above mentioned formulations would have been routinely made by those of ordinary skill in the art and is considered within the ability of tasks routinely performed by them without undue experimentation, especially in light of the oral dosage forms provided in O'Malley (see coumn 4, lines 31-36 and column 6, line 9 of USP'970).

With respect to the specific amounts of bupropion, "about 30mg to about 300mg", in claims 52-53 and 57-58, the examiner determines that such amounts deems to be an expected feature or property to the known antidepressant amount or antismoking cessation amount of bupropion (see column 4, lines 32-38 of USP 6197827 for your reference: USP'827 discloses a range of about 50 mg to about 300 mg per day of bupropion as antidepressant amount or antismoking amount). Therefore, the references in combination make obvious the instant invention.

With respect to the instantly claimed "a weight loss affecting amount", since the referenced amounts of naltrexone and antidepressant amount of bupropion overlap with the instant "weight loss affecting amount" of naltrexone and bupropion (which about 5mg to about

50mg of naltrexone and about 30mg to 300mg of bupropion), the references in combination make obvious the instant invention.

As discussed above, the applicant's statement of "the affecting weight loss" is not limited to the interpretation of the composition claims since such property or characteristic deems to be expected feature of the referenced composition (due to overlapping dosage amounts). Thus, the cited references in combination make obvious the instant invention.

Relevant Art of Record

5. The prior art made of record and not relied upon is considered pertinent to applicant's invention. Dante (US 5817665, USP 5512593 or USP 6034091) teaches a composition comprising naltrexone in combination with bupropion that is useful for the treatment of depression; Gadde et al. (US 7109198) teaches use of bupropion including sustained release for the treatment of obesity; and Chen et al. (US 6210716) teaches use of sustained release bupropion for the treatment of smoking cessation or depression.

Response to Arguments

6. Applicant's arguments and Declaration filed 06/29/07 have been fully considered but they are not persuasive.

Applicant's argument in the response takes the position that O'Malley does not discloses each and every element of the claimed invention, and fails to discloses the elements arranged as claimed. Applicant alleges that only by impermissible using hindsight would the Examiner to elect to combine naltrexone and bupropion in a composition formulated for oral administration- this combination of elements is not taught by O'Malley.

This argument is not found persuasive. Unlike the applicant's argument, O'Malley teaches or suggests that the combined treatment (opiate antagonist such as naltrexone in combination with antidepressants including bupropion (commercially known as Wellbutrin)) can be administered simultaneously (Webster's II New Riverside University Dictionary defines "simultaneous" as "occurring, existing or carried out at the same time"). Thus, the examiner determines that the referenced simultaneous administration "metes and bounds" the instant combination composition and makes obvious the instant invention. See column 6, lines 1-6 and 22.

Furthermore, O'Malley teaches or suggests that "agents to treat nicotine withdrawal such as antidepressants by any conventional means, such as, for example oral administration of tablets, capsules, granules or other edible composition..." can be administered in conjunction with the opioid antagonist (column 6, lines 7-10); and that the opioid antagonist such as naltrexone can be administered or taken orally (column 4, lines 30-31). As discussed above, determination of the appropriate dosage forms for treatment involving each of the above mentioned formulations would have been routinely made by those of ordinary skill in the art and is considered within the ability of tasks routinely performed by them without undue experimentation, especially in light of the oral dosage forms provided in O'Malley. There are general references indicating that pharmaceuticals generally may be delivered oral dosage forms, as well as disclosing benefits or advantages to be achieved by oral dosage forms versus other modes of administration, for example sustained release preparation, intravenous, intramuscular or intradermal, e.g., by sterile injections, including depot versions, implants, parenteral

administration, therefore, there exist general art accepted motivations for formulating drugs for oral dosage forms.

Especially considering the state art (anti-smoking therapy art) of at the time of the invention was made, ordinary skill in the art would have expected as taught by O'Malley that any conventionally known bupropion dosage forms, for example bupropion hydrochloride sustained release (Zyban) which was approved by FDA in May, 1997 for the treatment of smoking cessation (see "Approval Letter" of Application Number:NDA 20-711, Department of Health & Human Services, May 14, 1997), would be suitable for the referenced combinational therapy. Thus, one would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same ingredients and share common utilities, and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's argument in the response takes the position that the unexpected results or synergistic effects of the combination of naltrexone and sustained release bupropion provided by the applicant is not suggested or taught in the prior art.

Applicant's objective evidence or secondary consideration of showing unexpected results was carefully considered. However, the examiner finds that such evidence is not found persuasive. As discussed in preceding comments, the combination composition comprising naltrexone and bupropion, in any available dosage forms including sustained release forms (e.g., sustained release tablet) was well known at the time of the invention was made. Based upon preponderance evidence of the prior art, the instant combination is considered obvious under 35 U.S.C. 103.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. No Claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on (571) 272-0718. The fax number for this Group is (571) 273-8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see http://pair-direct.uspto.gov Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Brian Kwon
Primary Patent Examiner
AU 1614